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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,312	11/06/2003	Yoshinori Sekine	F-8028	8003
28107	7590	11/14/2007	EXAMINER	
JORDAN AND HAMBURG LLP			DICUS, TAMRA	
122 EAST 42ND STREET			ART UNIT	PAPER NUMBER
SUITE 4000			1794	
NEW YORK, NY 10168				
		MAIL DATE	DELIVERY MODE	
		11/14/2007	PAPER	

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/702,312
Filing Date: November 06, 2003
Appellant(s): SEKINE, YOSHINORI

MAILED
NOV 14 2007
GROUP 1700

C. Bruce Hamburg and
Ricardo Unikel
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 08-16-07 appealing from the Office action mailed
12/14/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,933,044	ISHIKAWA	08-2005
6,682,679	MARENTIC ET AL.	01-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,933,044 to Ishikawa.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37

CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Ishikawa teaches an insert-molded article comprising a film having transparency (2, FIGS. 3 and 4 and associated text), thermosoftening decorative print layer printed by use of a crosslinking printing ink (7, FIGS. 3 and 4 and associated text) and a binder layer printed with use of a low crosslinking printing or non-crosslinking printing ink (8, FIGS. 3 and 4 and associated text), injected molded resin (4, FIGS. 3 and 4 and associated text). See also 5:1-25 and 6:5-50. The resins used in the layers are of polyester and the binder layer is partially crosslinked (equivalent to low-crosslinking effect of instant claims 3-4). The ink is also of crosslinked polyester (5:25-30). Claims 1-12 are met.

Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,682,679 to Marentic et al.

Marentic teaches an insert-molded article comprising a film having transparency (3:50-55, e.g." clear" such that an image covered by the clear coat is substantially visible through the clear coat), thermosoftening decorative print layer printed by use of a crosslinking printing ink and a binder layer printed with use of a low crosslinking printing or non-crosslinking printing ink (3:5-20, 3:40-45, e.g. one or more intermediate crosslinkable polymer (binder) ink film having a desired image placed one on top of the other and the intermediate layers need not include a catalyst for crosslinking but can during the molding process), and a resin

molded (4:30-55, 26, FIG. 7 and associated text, 15:35-16:20). See also 2, lines 15-68 and FIGS. 5-8 and associated text.

That the resin is molded by injection is a product by process limitation. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

Claims 1, and 7-12 are met.

Marentic teaches a crosslinked polyester resin and methacrylic resins (6:40-7:30) per instant claims 2 and 5-6.

Marentic also explains that in addition to just using one polyester ink base, a secondary saturated acid added in the crosslinked polyester resin ink effectively reduces the crosslinking and rigidity (7:1-5), thus this explanation is equivalent to a low-crosslinking ink degree that is lower than the other in the print layer as recited in claims 3-4.

(10) Response to Argument

Appellant argues that Ishikawa does not teach instant claim 1, namely arguing a metallic luster layer as a decorative print layer. However, Appellant noted FIG. 4, and the Examiner also referenced FIG. 4 and associated text, which clearly shows 7 and 8 having crosslinking ink and

where 8 may contain a small amount or may not contain crosslinking agents which is equivalent to the instant binder layer printed with low or non-crosslinking printing ink., and such layers are not to be confused with a metallic luster layer. That the layers are printed on are process-derived limitations that are given little weight. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same. The overall structure is in the following order as depicted in FIG. 4: transparent film (2), thermosoftening decorative print layer of crosslink ink (7), binder layer of lower degree crosslink ink (8), and resin layer (4). See further col. 3, lines 20-23, and col. 6, lines 1-20. Also Appellant's claim does not exclude additional layers.

Appellant further argues the thermosoftening decorative print layer, which in Ishikawa is not described as having any degree of crosslinking at all. As recited above, both 7 and 8 have crosslinking. See again col. 6, lines 1-20 of Ishikawa explicitly stating the crosslinking (partial) of 7 and crosslinking that is lower or not at all of 8. Appellant's claim does not recite what crosslinking full/partial degree of 7 is, other than the comparison relayed by noting 8, which is explicitly taught by Ishikawa also (see "8 consists of a thermoplastic resin without crosslinking, or with a degree of crosslink lower than the first 7" in col. 6, lines 1-5).

Appellant alleges the binder layer is not transparent, however, col. 6, lines 15-18 state vinyl chloride-vinyl acetate copolymer is employed as 8 and thus inherently has a degree of transparency. Further the resin is the same as Appellant uses in claims 5-6, and 10-12.

Marentic teaches decorative transfers on molded layers wherein decorative intermediate layers include crosslinkable polymer bases and ink film layers (3:5-10-20), where the second uppermost outer layer is a resin clear gel coat (3:35-40) that may or may not include an ink film crosslinkable polymer base, and the innermost intermediate layer is a resin that may or may not include an ink film crosslinkable polymer base (3:40-60). See 3:40-42 and 4:25-30 (therein taught also screen printed inks). One or more intermediate layer can be deposited, where both ink and resin films are in separate intermediate layer or in one layer (5:23-30). Marentic explicitly explains that by "clear" he means a resin that is transparent so that an image placed on it is visible (3:50-55). The inks may also be non-crosslinkable vinyl or acrylic inks (6:25-51) or crosslinked with an acid. See further after explaining FIG. 5, Marentic explicitly recites all the intermediate layers, color gel and molded structure is left on the mold surface for crosslinking to occur (15:5-15) and that the polymers in each of the layers are crosslinked.

The said intermediate layers are exemplified in FIG. 5 as 16 and 14, despite Appellants allegation that Marentic does not show an example, where the layers are on a polymer resin color gel coat 22 (13:3-5) and resin mold 24. That the resin mold is molded by injection is a process-derived limitation given little weight. See product by process rationale above. The fact that Marentic teaches 16 is clear and transparent, it is considered the same as "a film having transparency", and the crosslinking print intermediate layers are the additional layers of 16 or 14 (discussed in plurality above, which is relied upon and need not show every single arrangement

as Marentic taught the modifications may be made to the embodiments in col. 3), thereby forming the thermosoft decorative print layer using crosslinking printing ink and binder layer with low-crosslinking printing ink, and the resin mold layer is equivalent to again 22 or 24.

Because non-crosslinkable polymer (vinyl or acrylic) inks are used and crosslinking takes place in this intermediate layer (see again 6:25-51, 7:1-28, and 15:5-15), it is considered to meet the ambiguous “low”-crosslinking ink of the instant binder layer.

Because Marentic teaches the polymer base of the inks can include polyester for crosslinkable inks (same resin as Appellant uses in claims 5-6), and further adds as one of the reactants either a difunctional acid and/or a dihydroxyl alcohol, and maleic acid or anhydride, thus more crosslinking is taking effect as more crosslinking aids/ingredients are added (see again 6:40-55, 7:1-27). Thus because of this teaching, more crosslinking vs. less is taking place and when reading this in context with the intermediate layers that use this ink (with or without the crosslinking aids, in either the first or second of said layers), the binder layer having a lower crosslinking degree than the thermosoft decorative print layer is effected (as claimed per instant claims 1, and 3-4). Said teaching thus does not have to show a single embodiment in which every element is included, but must be sufficiently specific disclosure to place the invention in view of one having ordinary skill in the art. One or more, means it can contain 2, 3, and up to infinity and therefore need not show an embodiment for every single option, as the teaching is present. See MPEP 2123: Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). Furthermore, “the prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such

disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

The transparency is also present because the same polyester and methacrylic resins are taught by Marentic as cited above in the rejection, despite Appellant's allegations that transparency of the binder is not taught.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Tamra L. Dicus



Conferees:

Milton Cano,



/Romulo Delmendo/

Romulo Delmendo